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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/666,253	09/22/2003	Hidejirou Maehara	242936US2	9515

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EXAMINER

FRANKLIN, RICHARD B

ART UNIT PAPER NUMBER

2181

DATE MAILED: 01/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/666,253	MAEHARA, HIDEJIROU	
	<b>Examiner</b>	<b>Art Unit</b>	
	Richard Franklin	2181	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 November 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 15-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 November 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>11/25/2005</u> .  | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Election/Restrictions*

1. Newly submitted independent claims 15 – 28 is/are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: these claims are for an apparatus that creates a Web page containing detailed information about the problems detected in the image forming and reproducing process – classifiable in class 707 subclass 10.

Claim 11 link(s) invention I (claims 1 – 14) and invention II (claims 15 – 28). The restriction requirement between the linked inventions is subject to the nonallowance of the linking claim(s), claim 11. Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting restrictions over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for

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prosecution on the merits. Accordingly, claims 15 – 28 is/are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

2. Claims 1 – 14 have been examined.

### ***Claim Objections***

3. Claim 1 is objected to because of the following informalities:
  - As per claim 1, it appears that Applicant has unintentionally left off the preamble to the claim. The Examiner assumes that claim 1 was intended to have the preamble of the original Claim 1, which is “An image reproducing apparatus comprising...”Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 2 – 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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5. Claims 2, 4, 7, and 9 recite the limitation "The image reproducing apparatus according to claim 1" in the first line of each claim. There is insufficient antecedent basis for this limitation in the claim.

The Examiner assumes that Applicant unintentionally left off the preamble of claim 1 which recites the limitation of "An image reproducing apparatus" which is also what claims 2, 4, 7, and 9 are refer to.

6. Claim 9 recites the limitation "further comprising e-mail creating means" in the first and second lines of the claim. There is insufficient antecedent basis for this limitation in the claim.

It is not clear if the Applicant is referring to a new email creating means or the email creating means recited in claim 1. The Examiner has interpreted the limitation as referring to the email creating means of claim 1.

7. Claim 11 recites the limitation "the image reporting and reproducing process" in the last line of the claim. There is insufficient antecedent basis for this limitation in the claims.

The Examiner has interpreted the limitation as referring to the "image forming and reproducing process" as previously recited in claims 1.

8. Claim 12 recites the limitation "the URL of the Web page" in the last line of the claim. There is insufficient antecedent basis for this limitation in the claims.

The Examiner has interpreted the limitation as referring to "a URL of the Web page."

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9. Claim 12 recites placing a URL to a web page in the subject of an e-mail message. It is unclear if the URL is a link to the web page that a user can click on to display the web page, or simply a non-interactive text string that displays the web page address to the user.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1 – 2, 4 – 10, and 13 – 14 are rejected under 35 U.S.C. 102(e) as being anticipated by Muto US Patent Application No. 2002/0116480 (hereinafter Muto).

As per claims 1 and 13, Muto teaches an image forming part that carries out image forming and reproducing (Figure 1 Item 105, Paragraph [0040]); a data storage that stores a plurality of possible problems occurring in connection with an image forming and reproducing process, each problem being stored in association with addressee information and a problem ID code (Figure 1 Items 111 and 112, Paragraphs [0045], [0055], and [0056]); an acquiring unit that acquires problem information when one of the problem occurs in connection with the image forming and reproducing process (Figure 1 Item 106, Paragraph [0040]); an addressee determination unit that

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selects an addressee corresponding to one of the problems with reference to the data storage (Figure 1 Item 112, Paragraph [0045]); a communication unit that reports occurrence of one of the problems to the selected address (Figure 1 Item 113); and an email creating means that creates an email to report the occurrence of one of the problems to the selected addressee and inserts the problem ID code in the subject of the email (Figure 1 Item 108 and 112, Figure 10 Item 1004, Paragraph [0067]).

As per claim 2, Muto teaches wherein the forming and reproducing process includes at least one of a printing process for recording and outputting an image and a reading process for optically reading an original, and the image forming part includes at least one of a printing section that records and outputs the image, and a reading section that optically reads the original (Paragraph [0137]).

As per claim 4, Muto teaches the image apparatus further comprising a use information retaining unit that retains use information about the image reproducing apparatus, wherein the communication unit reports the occurrence of a problem together with the use information to the selected address (Figure 10 Item 1010, Paragraph [0069]).

As per claim 5, Muto teaches wherein the use information contains location information representing the location of the image reproducing apparatus (Figure 10 Item 1011, Paragraph [0069]).

As per claim 6, Muto teaches wherein the use information contains ID information for identifying the image reproducing apparatus (Figure 10 Item 1010, Paragraph [0069]).

As per claim 7, Muto teaches wherein the data storage stores one or more addressees as addressee information, in association with one of the problems (Figure 10 Item 1003, Paragraph [0067]).

As per claim 8, Muto teaches wherein the data storage stores a user of the image reproducing apparatus in association with one of the problems (Figure 7 Item S704, Figure 10 Item 1003, Paragraphs [0062] and [0067]).

As per claim 9, Muto teaches the email creating means that creates an email to report the addressee of the occurrence of one of the problems, wherein the data storage stores an email address as the addressee information, in association with one of the problems (Figure 10 Item 1003, Paragraph [0067])

As per claim 10, Muto teaches wherein the data storage stores a problem ID code in association with one of the problems (Figure 1 Items 111 and 112, Paragraphs [0045] and [0055] – [0056]), and the email creating means inserts the problem ID code



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in the subject of the email (Figure 1 Items 108 and 112, Figure 10 Item 1004, Paragraph [0067]).

As per claim 14, Muto teaches a data storage that stores a plurality of possible problems occurring in connection with an image forming and reproducing process, each problem being stored in association with addressee information and a problem ID code (Figure 1 Items 111 and 112, Paragraphs [0045], [0055], and [0056]); an acquiring unit that acquires problem information when one of the problem occurs in connection with the image forming and reproducing process (Figure 1 Item 106, Paragraph [0040]); an addressee determination unit that selects an addressee corresponding to one of the problems with reference to the data storage (Figure 1 Item 112, Paragraph [0045]); a communication unit that reports occurrence of one of the problems to the selected addressee (Figure 1 Item 113); and an email creating means that creates an email to report the occurrence of one of the problems to the selected addressee and inserts the problem ID code in the subject of the email (Figure 1 Item 108 and 112, Figure 10 Item 1004, Paragraph [0067]).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 3 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muto US Patent Application No. 2002/0116480 (hereinafter Muto) as applied to claims 1 – 2, 4 – 10, and 13 – 14 above in view of Parry US Patent No. 6,666,594 (hereinafter Parry).

As per claim 3, Muto teaches a printing process management unit that monitors and detects printing problems occurring in connection with the printing process (Muto; Figure 1 Item 106).

Muto does not teach a reading process management unit that monitors and detects reading problems occurring in connection with the reading process.

Parry teaches an error detection unit that detects errors in the printing and reading process (Parry; Figure 1 Item 23, Col 5 Lines 1 – 7).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the teachings of Muto by those of Parry to include the reading process error detection.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the teachings of Muto by those of Parry because including the reading process error detection allows for errors to be detected in the reading process and reported to the user in the same fashion as printing errors.

As per claim 11, Muto does not teach a Web page creating means that creates a Web page containing detailed information about the problems detected in the image forming and reproducing process.

Parry teaches a web page creating means that creates a Web page containing detailed information about the problems detected in the image forming and reproducing process (Parry; Figure 1 Item 12, Col 8 Lines 9 – 25, Claim 22).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the teachings of Muto by the teachings of Parry to include the Web server.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the teachings of Muto by those of Parry because including the Web server allows additional information to be displayed to the user as well as the whole history of printer errors (Parry; Col 8 Lines 9 – 25).

### ***Response to Arguments***

12. In response to Office Action of August 9, 2005, Applicant argues that Parry US Patent No. 6,666,594 (hereinafter Parry) is not a valid reference against the pending claims because “Parry has as an earliest effective filing date April 24, 2003, thus, Parry does not have a valid filing date prior to applicants perfected priority date of September 20, 2002.” This argument is incorrect because the earliest effective filing date of Parry is October 19, 2001, which is prior to applicant’s priority date of September 20, 2002. The date of April 24, 2003 is the date the application for Parry was published. Under 35

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U.S.C. 102(e), a person is entitled to a patent unless “the invention was described in an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent (emphasis added).” Therefore, Parry is clearly an acceptable reference against the pending application.

13. Applicant's arguments with respect to claims 1 – 14 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard Franklin whose telephone number is (571) 272-0669. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Huynh can be reached on (571) 272-4147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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KIM HUYNH  
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1/8/06